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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/059,278      | 01/31/2002  | Larry E. Mashburn    | 12317-907720        | 5374             |

181 7590 03/04/2005  
MILES & STOCKBRIDGE PC  
1751 PINNACLE DRIVE  
SUITE 500  
MCLEAN, VA 22102-3833

EXAMINER

JUSKA, CHERYL ANN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1771

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                               |                                 |  |
|---|-------------------------------|---------------------------------|--|
| <b>Advisory Action</b><br><b>Before the Filing of an Appeal Brief</b> | Application No.<br>10/059,278 | Applicant(s)<br>MASHBURN ET AL. |  |
|   | Examiner<br>Cheryl Juska      | Art Unit<br>1771                |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 16 February 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

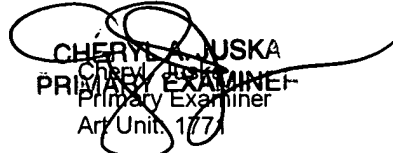
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

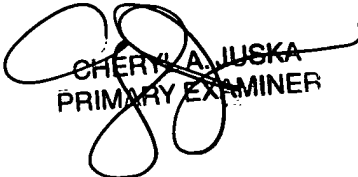
8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
**CHERYL A. JUSKA**  
 PRIMARY EXAMINER  
 Primary Examiner  
 Art Unit 1771

Continuation of 11. does NOT place the application in condition for allowance because: Applicant traverses the prior art rejection based upon Kurth '488 by asserting the present application should be granted the priority date of provisional application 60/275,631 and that the date of said provisional application would remove Kurth '488 as a reference. Specifically, applicant asserts, according to the controlling case law of *In re Wertheim*, 191 USPQ 90, said provisional application provides adequate support for the claimed ranges. The examiner is aware of *Wertheim*, but does not believe it is applicable to the present application. In particular, *Wertheim* held that disclosure of a broad range is adequate support for a narrower range within said broad range. On the other hand, applicant is arguing that the working examples of the provisional application provide support for the range "at least 0.7 moles of OH groups per mole of bulk vegetable oil." [Note the working examples of the provisional application do not actually provide molar ratios, but rather pounds of alcohol per pound of oil and applicant has not shown or calculated the correlation of the pound ratio to molar ratio.] Applicant states that since both working examples have molar ratios above the minimum ratio required by the claim and since the lower ratio is substantially close thereto, the provisional application provides adequate support for the present claims. The examiner respectfully disagrees in that the range claimed is an open-ended range wherein the examples supposedly have molar ratios within said open-ended range. This is significantly different from *Wertheim's* narrowing of a disclosed broad range. A few exemplary values cannot provide adequate support for an open-ended broad range. Hence, applicant's argument is unpersuasive. Additionally, as noted in the last Office Action, the effective filing date of Kurth '488 is not October 10, 2001, but rather October 10, 2000--the filing date of provisional application 60/239,161. Kurth '488 is given this date despite its status as a CIP application, since the CIP application provides the required support for the subject matter of Kurth '488. Additionally, Kurth '488 has a separate, direct claim to provisional application 60/239,161 filed 10/10/00. Hence, the above debate over whether the present provisional application 60/275,631 filed 03/15/01 is really irrelevant since this date is insufficient to predate the effective filing date of the Kurth '488 reference (10/10/00).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER